IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Vali Tadayon, et al   : Paper No:

Serial No.   09/944,663   : Group Art Unit:

Filed: August 31, 2001   : Examiner:

For: ACTIVE FILE SYSTEM

INFORMATION DISCLOSURE STATEMENT

THE ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

Dear Sir:

In accordance with 37 C.F.R. §§1.97 and 1.98, Applicants herewith submit certain references which the Patent & Trademark Office may wish to consider in examining the above-identified application. With the exception of the Statement of Development of the Invention (the first reference listed under "Other References", all of the references and information were provided in the Information Disclosure Statements (IDS) previously filed for application 09/421,808 on the following dates: October 20, 1999, January 11, 2001, and October 11, 2001. References may be traced to the appropriate IDS by the color and font used to illustrate the reference. Green, capitalized references were submitted in an IDS dated October 20, 1999. Blue, plain font references were submitted in an IDS dated January 11, 2001. Red, italicized references were from the supplemental IDS filed on October 11, 2001. A copy of each original IDS is attached. The listed references are also listed on the attached Form PTO-1449. The regulation defined by 37 C.F.R. 1.98(d) permits the filing of references without copies, however, if an additional set of copies is desired by the Examiner, Applicant respectfully requests that Examiner contact Applicant and an additional set of copies will be produced and sent to the Examiner.

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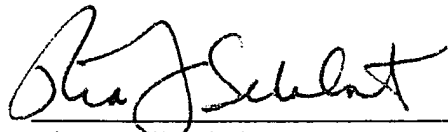OLE-DB Simple Provider: A Data Binding API for IE4/MSHTML; http://msdn.microsoft.com/workshop/database/databind/simpletabulardata.asp; viewed on 10/20/00; pp. 1-6 (Box B)

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Copies of the listed references are provided. No representation is made or intended that a prior art search has been made or that no better art than the listed is available. It is respectfully requested that the information be considered by the Examiner and made of record in the present application.

The Assistant Commissioner for Patents is authorized to charge any deficiency or credit any overpayment to Frost Brown Todd LLC Deposit Account No. 06-2226.

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_10/29/01_____, 2001

CERTIFICATE OF MAILING

I hereby certify that a copy of this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to The Assistant Commissioner of Patents, Washington, D.C. 20231 this _____ day of _____, 2001.

DEVELOPMENT OF THE INVENTION

Development of the present invention stemmed from a previously developed invention, Web-Based Active Virtual File System, for which a patent application was filed on September 29, 1999.

TF Logic, Inc. (*hereinafter,* TF Logic) and Lang Financial Systems, Inc. (*hereinafter,* Lang) arranged a meeting to discuss details of the Web-Based Active Virtual File System for June 22, 2000. Contemporaneous with the meeting, the parties negotiated and signed an Agreement of Confidentiality (*please see* attached) regarding the technology discussed at the meeting. Participants in this meeting included Pat Osterday, Vali Tadayon, Chuck Zwick, Jim Wilson, and Stan Lang. In the course of this meeting, ideas for enhancements to the Web-Based Active Virtual File System were also discussed including an artistic conception (*please see,* attached Figure 1) for a new type of directory system for the Web-Based Active Virtual File System. One purpose of this meeting was to determine whether or not the new directory system would be useful to an entity such as Lang and, therefore, worthwhile for TF Logic to develop. Ultimately, this new type of directory system was developed by TF Logic and a non-provisional, continuation-in-part patent application was filed on this improvement on August 31, 2001. The new patent was entitled, "Active File System." At the time of this meeting, however, the new directory system was merely an idea and development work had not yet begun.

"Public use" of a claimed invention under 35 U.S.C. § 102(b) occurs when the inventor allows another person to use the invention without limitation, restriction or obligation of secrecy to the inventor." MPEP § 2133.03(b). The secret nature of the parties' discussions was preserved by signed Agreements of Confidentiality. Furthermore, because no invention existed at the time of these discussions, it was impossible for TF Logic to allow Lang to use the invention. Therefore, no "public use" was made of the idea of this invention.

A "sale" is a contract between parties wherein the seller agrees to "give and to pass rights of property" in return for the buyer's payment or promise "to pay the seller for the things bought or sold." MPEP § 2133.03(b)(I). It must be demonstrated by clear and convincing evidence that "there was a definite *sale* or *offer to sell* by more than one year before the application for the subject patent, and that the subject matter of the sale or offer to sell fully anticipated the claimed invention. Group One, Ltd. v. Hallmark Cards, Inc., 254 F.3d 1041, 1045-1046 (Fed. Cir. 2001) *quoting* UMC Elecs. Co. v. United States, 816 F.2d 647, 656, 2 USPQ2d 1465, 1472 (Fed. Cir. 1987). The Supreme Court further refined this test by requiring a) a commercial offer for sale and b) that the invention must be ready for patenting. Pfaff v. Wells Electronics, Inc., 525 U.S. 55 (1998). Such an offer for sale must meet the level of an offer for sale in the contract sense [generally, under the Uniform Commercial Code or Restatement of Contracts]. Group One, Ltd. v. Hallmark Cards, Inc., 254 F.3d 1041, 1047-48 (Fed. Cir. 2001).

The correspondence between TF Logic and Lang did not amount to a commercial offer to sell the invention for two reasons. First, there was no discussion of price or delivery date for software embodying the new directory system. Second, no invention existed at the time of these discussions, only an idea for an invention. Therefore, the discussions which occurred on June 22, 2000, would not raise any on-sale bar issues for the currently pending application.

This disclosure has been submitted so that applicant fully complies with the duty of candor and good faith imposed by section 37 C.F.R. 1.97. Applicant, however, believes that this disclosure will not affect the patentability of the currently pending application 09/944,663.

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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Vali Tadayon, et al : Paper No:

Serial No. 09/421,808 : Group Art Unit:

Filed: October 20, 1999 : Examiner:

For: **METHOD AND APPARATUS FOR AN ACTIVE FILE SYSTEM**

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Dear Sir:

In accordance with 37 C.F.R. §§1.97 and 1.98, Applicants herewith submit certain patent references and other information, which the Patent & Trademark Office may wish to consider in examining the above-identified application. The references and information are provided below, and are also listed on the attached Form PTO-1449.

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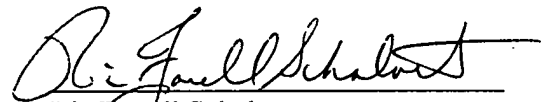
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Copies of the listed references are provided. No representation is made or intended that a prior art search has been made or that no better art than the listed is available. It is respectfully requested that the information be considered by the Examiner and made of record in the present application.

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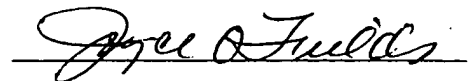
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